



PATENT

Customer No. 22,852

Attorney Docket No. 08350.1409-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Alan L. FERGUSON et al.) Group Art Unit: 2191
Application No.: 10/016,785)
Examiner: M. Steelman
Filed: December 6, 2001) Confirmation No. 3421
For: SYSTEM AND METHOD FOR)
REMOTELY MODIFYING)
SOFTWARE ON A MACHINE)

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Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action dated May 16, 2005. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicants concurrently file the Request with a Notice of Appeal prior to filing an Appeal Brief; and (3) Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

Applicants have met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness in Rejecting Claims 1-27 Under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, the Examiner must show, among other things, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03.) In rejecting claims 1-27 under 35 U.S.C. § 103(a), the Examiner admits *Cantos et al.* and *Lee et al.* do not teach the recitations of claims 1-27 within a “work machine.” (Final OA at 4.) To satisfy this deficiency, the Examiner asserts it would have been obvious to combine *Cantos et al.* and *Lee et al.* in a work machine based on the teachings of *Hanson et al.* (*Id.*) As explained in the Request for Reconsideration filed July 14, 2005 (“the Request”), *Hanson et al.* does not teach or suggest the missing recitations as asserted by the Examiner. (See the Request, I(a), pp. 3-5.)

For example, as noted in the Request, the update(s) recited in claims 1-27 are stored or installed in a non-volatile memory of a work machine. Contrary to the Examiner’s assertions, however, *Hanson et al.* does not teach “updating software installed on a work machine.” (See Final Office Action at 4, line 2.) Instead, *Hanson et al.* discloses a portable data terminal that includes software that contains “downloading/updating control programming.” (See *Hanson et al.* at 17:49-50.) The data terminal, however is not part of a work machine, but instead is a removable device that is connected to a vehicle through a receptacle. Indeed, as mentioned in the Request, *Hanson et al.* teaches away from having the terminal fixed to a particular location. (See the Request at 3.)

In response to Applicants’ arguments, the Examiner issued an Advisory action on August 12, 2005 maintaining the rejection of claims 1-27 in view of the cited art. The Examiner, however, does not address any of the above-referenced arguments, which are directed toward the rejection’s lack of showing of a *prima facie* case of obviousness. Instead, the Examiner comments solely on Applicants’ arguments regarding the lack of a suggestion to combine that was argued in section I(b) of the Request. (See Advisory Action, 111(A) and the Request at 5-8.) Accordingly, the Examiner has not provided comments or reasons why the cited art, taken alone or in combination, teaches or

suggests each and every element of claims 1-27, as refuted by Applicants in the Request. As such, neither the rejection, nor the Examiner's comment in the Advisory Action, meet the requirements for establishing a *prima facie* case of obviousness.

Further, the Examiner's reason for combining the reference is conjecture. In addressing Applicants' arguments regarding the lack of a suggestion to combine the cited art (See the Request, I(b) at 5-8), the Examiner applies a different reasoning than that presented in the Final Office Action for combining *Hanson et al.* with *Cantos et al.* and *Lee et al.* Neither reasoning supports the motivation asserted by the Examiner. For instance, in the Final Office Action, the Examiner asserted the alleged combination would have been obvious because *Hanson et al.* discloses, among other things, "vehicle controller/computers are known in the art . . . [t]he ability to (Hanson col. 1, line 53) 'survive rough handling' . . . the need to download/upload control programming and application programming . . ." (See Final Office Action at 4-5.) Applicants addressed the deficiencies in the Examiner's positions in the Request. (See the Request at 6-7, discussing the reasons for combining the cited art set forth by the Examiner do not address the asserted combination, i.e., updating software in memory in a work machine.)

In the Advisory Action, the Examiner now asserts the alleged combination would have been obvious because "Hanson likewise, noted the need to automate the software of remote clients (col. 2, lines 6-12.[])." This statement does not establish the requisite motivation for rejecting claims 1-27 under 35 U.S.C. § 103(a) for at least the reason that updating remote client software does not address updating or installing software in a memory of a work machine, as recited in claims 1-27. As alleged in the Final Office Action, the Examiner presents *Hanson et al.* to allegedly suggest the "invention installed in a work machine." This is not shown or supported by the Examiner's reliance on *Hanson et al.*

Further, the Examiner associates a work machine with a remote client and asserts "[a]s any remote client, maintaining and updating the controllers in a simple efficient manner enhances the usability." (Advisory Action at 11(A).) The Examiner, however, does not support these allegations with evidence. Instead, the Examiner makes conclusions without support from at least the cited art to show that one skilled in

the art would have been motivated to make the alleged combination of the cited art. As such, the Examiner has not addressed the fact that none of *Hanson et al.* or the other cited art teaches or suggests updating software in a memory of a work machine, as recited in claims 1-27.

The Examiner is also off base in asserting, “knowledge in the art, at the time of the invention suggests successful remote updates of software located on client machines, regardless of the type of client machine involved.” In fact, the type of machine is important. As explained in the Request, independent claims 1, 12, and 26 require, among other things, that updates be stored or installed in a non-volatile memory of a work machine. (See the Request at 3-4.) Thus, the knowledge in the art, as alleged by the Examiner, must consider the type of “machine involved.” This is bolstered by the fact that *Cantos et al.* and *Lee et al.* are not even remotely associated with work machines or updating software in memory of a work machine. Further, while *Hanson et al.* discloses a portable terminal that may interface with a vehicle, *Hanson et al.* is directed toward the portable terminal and its components, such as internal memory, and not vehicle components or a memory thereof. Along these lines, and as argued by Applicants in the Request, one skilled in the art would not look to modify computer network systems, as disclosed by *Cantos et al.* and *Lee et al.*, with a portable data reader terminal system disclosed by *Hanson et al.* to teach or suggest the recitations of claims 1-27. (See the Request at 6-7.)

III. Conclusion

In light of the above arguments and those presented in the Request, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 1-27. Therefore, the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

Respectfully submitted,

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Dated: September 12, 2005

By: 
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